
REMARKS

Applicants submit these remarks in response to the Final Office Action of July 31, 2003. In the Final Office Action, newly added claims 41-50 were subjected to an election/restriction requirement and were withdrawn by the Examiner for being directed to a non-elected invention.

In the Final Office Action, the Examiner rejected claims 1-5, 35-36, and 38-40 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 4,179,866 to Graham et al. ("Graham"). The Examiner also rejected claims 6-9 under 35 U.S.C. § 103(a) as being obvious over Graham in view of U.S. Patent 4,550,549 to Reinfeld et al. ("Reinfeld").

In this amendment, Applicants amend claims 1-4 and 35 and offer arguments distinguishing the claims from the cited references, thereby overcoming the claim rejections. Applicants respectfully submit that claims 1-9, 35-36 and 38-40 are patentable over the prior art of record. Accordingly, Applicants request a notice of allowance.

35 U.S.C. § 102(b) Rejections of Claims 1-5, 35-36, and 38-40

The Examiner rejected claims 1-5, 35-36, and 38-40 under 35 U.S.C. § 102(b) as being anticipated by Graham. A claim is anticipated only if each and every element as set forth in the claim is found in a single prior art reference. MPEP § 2131.

Independent claim 1 recites, "[a]n apparatus for packaging goods in an open-bottomed box erected from a flat-folded configuration to receive at least one good, the open-bottomed box having sidewalls that define a bottom opening and wherein the bottom opening does not have flaps for closing the bottom opening" Similarly, independent claim 35 recites, "[a] method

for packaging goods in an open-bottomed box having sidewalls that define a bottom opening and wherein the bottom opening **does not have flaps** for closing the bottom opening,"

Unlike independent claims 1 and 35, Graham discloses a box "with opposed lower side flaps 16 and front and rear flaps 17, 18 which depend downwardly from the upright walls 12, 13." *Graham specification, col. 2, ll. 15-17*. Thus, Graham does **not** disclose, teach or suggest an apparatus or a method "for packaging goods in an open-bottomed box ... having sidewalls that define a bottom opening and wherein the bottom opening **does not have flaps**." For at least this reason, Graham fails to anticipate each and every element as set forth in independent claims 1 and 35. Since claim 36 depends on independent claim 35, and claims 2-9 and 38-40 depend on independent claim 1, Graham also fails to anticipate these claims as well. Therefore, Applicants respectfully request that the anticipation rejection be reconsidered and withdrawn.

35 U.S.C. § 103(a) Rejections of Claims 6-9

The Examiner rejected claims 6-9 under 35 U.S.C. § 103(a) as being obvious over Graham in view of Reinfeld. In order for a combination of references to establish a case of prima facie obviousness, three requirements must be met:

1. there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings;
2. there must be a reasonable expectation of success; and
3. the prior art references when combined must teach or suggest all the claim limitations.

MPEP §2142.

As explained in the preceding section, Graham does not disclose, teach, or suggest “[a]n apparatus for packaging goods in an **open-bottomed box erected from a flat-folded configuration ... wherein the [box] does not have flaps** for closing the bottom opening.” This is an element of independent claim 1, which is the claim on which claims 6-9 depend. Reinfeld does not remedy the deficiencies of Graham. Therefore, the Graham/Reinfeld combination fails to teach or suggest all of the limitations recited in claims 6-9. As a result, Applicants respectfully request that the obviousness rejection be reconsidered and withdrawn.

CONCLUSION

In view of the preceding remarks, Applicant respectfully urges that the Examiner’s rejections be reconsidered and withdrawn, and that claims 1-9, 35-36 and 38-40 be allowed. However, if the Examiner believes that any issues remain unresolved, the Examiner is invited to telephone the undersigned to expedite allowance.

Respectfully submitted,

DORSEY & WHITNEY LLP
Customer Number 25763

Date: 9/26/03

By: 

Devan V. Padmanabhan
Reg. No. 38,262
Intellectual Property Department
Suite 1500
50 South Sixth Street
Minneapolis, MN 55402-1498
(612) 343-7990